UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,499	08/01/2001	Kenzo Sekiguchi	2922.0045	3225

5514 7590 10/19/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
HUNTSINGER, PETER K	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/918,499	SEKIGUCHI, KENZO	
	Examiner	Art Unit	
	Peter K. Huntsinger	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/31/05*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filled on 31 August 2005 has been entered in full.

2. Based on the applicant's amendment, the objection to claim 20 has been withdrawn.

Response to Arguments

3. Applicant's arguments filed 31 August 2005 have been fully considered but they are not persuasive.

Applicant argues that:

Nothing in Toyoda, Kilcommons et al. or Okada teach automatically carrying out a controlling operation so as to retransmit an electronic mail which has been transmitted by transmitting means and which image data with a capacity thereof converted into a smaller capacity is attached, by the transmitting means, in response to receiving means receiving an electronic mail for notifying an error.

a. The examiner respectfully disagrees. Okada discloses control means for carrying out a controlling operation so as to retransmit the electronic mail, to which the image data with the capacity thereof converted by said converting means is attached, by said transmitting means (col. 8, lines 37-39). Okada further discloses the control means retransmits the email automatically (col. 8,

lines 25-28) in response to receiving an email notifying an error (col. 8, lines 14-15). The returned email is considered an electronic mail for notifying an error because the email was sent and returned marked as undelivered (col. 7, lines 44-47). This process is considered automatic because it occurs without user interaction.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 2, 4, 6, 11-13,15, 17, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and Okada U.S. Patent 6,101,244.

Referring to claims 1, 12, and 23, Toyoda discloses a communication apparatus, method, and program (col. 3, lines 25-27) comprising: connecting means for connecting the communication apparatus to a communication network containing an electronic mail exchange device (LAN I/F 24 of Fig. 2, col. 3, lines 14-24); input means for inputting image data representing an image (col. 3, lines 55-56); transmitting means for transmitting an electronic mail, to which the image data inputted by said input means is attached, via said connecting means (col. 3, lines 33-36); receiving means for receiving an electronic mail for notifying an error via said connecting means (col. 4, lines 42-47);

analyzing means for analyzing the electronic mail for notifying the error received by said receiving means (col. 4, lines 45-48). Toyoda does not disclose expressly converting the image into a smaller capacity. Killcommons et al. disclose converting means for converting a capacity of the image data, inputted by said input means, into a smaller capacity according to an analysis result obtained by said analyzing means (col. 9, lines 50-67). Toyoda and Killcommons et al. are combinable because they are from the same field of electronic messaging of image data. At the time of the invention, it would have been obvious to one of ordinary skill in the art to compress image data in an email in the system of Toyoda. The motivation for doing so would have been to reduce the size of the email being sent. Further, it is common to compress image files because they require greater memory space than text files. Toyoda and Killcommons et al. do not disclose expressly retransmitting an email. Okada discloses control means for automatically carrying out a controlling operation so as to retransmit the electronic mail, to which the image data with the capacity thereof converted by said converting means is attached, by said transmitting means, in response to said receiving means receiving the electronic mail for notifying the error (col. 8, lines 37-39). Okada further discloses the control means retransmits the email automatically (col. 8, lines 25-28) in response to receiving an email notifying an error (col. 8, lines 14-15). The returned email is considered an electronic mail for notifying an error because the email was sent and returned marked as undelivered (col. 7, lines 44-47). This process is considered automatic because it occurs without user interaction. Toyoda and Okada are combinable because they are from the same field of facsimile and email communication

devices. At the time of the invention, it would have been obvious to one of ordinary skill in the art to retransmit an email in the system of Toyoda. The motivation for doing so would have been to attempt to deliver email again if the email is not received. It is common to try to retransmit an email after an error to determine if the error is only a temporary lapse in communication. Therefore, it would have been obvious to combine Killcommons et al. and Okada with Toyoda to obtain the invention as in claims 1, 12 and 23.

Referring to claims 2 and 13, Killcommons et al. disclose wherein said converting means converts the capacity of image data specified by the electronic mail analyzed by said analyzing means (col. 9, lines 50-67).

Referring to claims 4 and 15, Killcommons et al. disclose wherein said converting means reduces the capacity by reducing a size of an image represented by the image data inputted by said input means (col. 9, lines 50-67).

Referring to claims 6 and 17, Killcommons et al. disclose wherein said converting means reduces the capacity by raising a compression rate of the image data inputted by said input means (col. 9, lines 50-67).

Referring to claims 11 and 22, Okada discloses wherein said control means repeats the conversion by said converting means and the retransmission by said transmission means every time said receiving means receives an electronic mail for notifying an error (S31 of Fig. 5, col. 8, lines 14-15) (col. 8, lines 37-39). If an email message is detected as disclosed by Okada, the process of Fig. 5 will occur which includes retransmitting an email.

6. Claims 3, 8-10, 14, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and Okada U.S. Patent 6,101,244 as applied to claims 1 and 12 above, and further in view of Kodaira et al. U.S. Patent 6,868,183.

Referring to claims 3 and 14, Killcommons et al. disclose converting an image into smaller data but do not disclose expressly lowering a resolution of an image. Kodaira et al. disclose wherein said converting means reduces the capacity by lowering a resolution of an image represented by the image data inputted by said input means (col. 24, lines 31-44). Toyoda and Kodaira are combinable because they are from the same field of image data processing. At the time of the invention, it would have been obvious to one of ordinary skill in the art to lower the resolution of an image in the system of Toyoda. The motivation for doing so would have been to reduce the size of the image file. Further, the commonly used image compression format JPEG compresses image data by lowering the resolution of an image. Therefore, it would have been obvious to combine Kodaira et al. with Toyoda, Killcommons et al., and Okada to obtain the invention as in claims 3 and 14.

Referring to claims 8 and 19, Kodaira et al. disclose wherein said converting means reduces the capacity by converting the image data which is multivalued image data, inputted by said input means, into binary image data (col. 24, lines 31-44).

Referring to claims 9 and 20, Kodaira et al. disclose setting means for setting for said converting means one of a plurality of conversion methods to be used; and wherein

said converting means converts the capacity by the conversion method set by said setting means (col. 24, lines 31-44).

Referring to claims 10 and 21, Kodaira et al. disclose a communication apparatus according to claim 1, wherein said converting means converts the capacity by using a combination of a plurality of converting methods (col. 24, lines 31-44).

7. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and Okada U.S. Patent 6,101,244 as applied to claims 1 and 12 above, and further in view of Kaneya J.P. Patent 411196218A.

Referring to claims 5 and 16, Killcommons et al. disclose reducing the data size of an image by compressing the data but do not disclose dividing the data into pieces. Kaneya discloses wherein said converting means reduces the capacity per electronic mail by dividing the image data inputted by said input means into a plurality of pieces. (English translated abstract). Toyoda and Kaneya are combinable because they are from the same field of transmitting image data over electronic messaging. At the time of the invention, it would have been obvious to one of ordinary skill in the art to divide an image into pieces in the system of Toyoda. The motivation for doing so would have been to reduce the size of a file and allow the file to be transmitted using email. Further, the dividing a file into separate pieces is common for reducing the time needed to transmit a file over the internet. Therefore, it would have been obvious to combine

Kaneya with Toyoda, Killcommons et al., and Okada to obtain the invention as in claims 5 and 16.

8. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and Okada U.S. Patent 6,101,244 as applied to claims 1 and 12 above, and further in view of Fukasawa U.S. Patent 6,243,174.

Referring to claims 7 and 18, Killcommons et al. disclose reducing the data size of an image by compressing the data but do not disclose converting color image data into black and white image data. Fukasawa discloses wherein said converting means reduces the capacity by converting the image data which is color image data, inputted by said input means, into black-and-white image data (col. 5, lines 47-55). Toyoda and Fukasawa are combinable because they are from the same field of facsimile devices. At the time of the invention, it would have been obvious to one of ordinary skill in the art to convert color data into black and white data for the system of Toyoda. The motivation for doing so would have been to reduce the size of an image. Further, grey scale is a common feature of facsimile devices that is used to reduce the cost of printing by not utilizing color ink. Therefore, it would have been obvious to combine Fukasawa with Toyoda, Killcommons et al., and Okada to obtain the invention as in claims 7 and 18.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

DOUGLAS Q. TRAN
PRIMARY EXAMINER